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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,075	04/26/2001	Jens Hake	RBL0071	2627

7590 04/23/2004

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EXAMINER

D AGOSTA, STEPHEN M

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,075

Applicant(s)

HAKE ET AL.

Examiner

Stephen M. D'Agosta

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 4. 6) ☐ Other: _____.

DETAILED ACTION

Priority

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on March 20, 2001 and April 13, 2001 are in compliance and accordingly, the information disclosure statement is being considered by the examiner.

Preliminary Amendment

The preliminary amendment has been received and the changes incorporated into the claims.

Specification

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

2. The disclosure is objected to because of the following informalities: **There appears to be missing text** – “Revised page 2a” has a sentence that trails off followed by an editorial note stating “text breaks off”. There is no connection from this page to the next page. The examiner reminds the applicant that NO NEW MATTER can be added in fixing this objection. Another similar error occurs on “Revised page 2” which also starts with a trailer from the first page as well. This requires correction.

-- The examiner also requests that the applicant show where each claim is discussed in the specification as well. This will ensure that each claim refers back to the specification and not to any missing portion (which would require cancellation of said claim). **Appropriate correction is required.**

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3. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) **TITLE OF THE INVENTION.**
- (b) **CROSS-REFERENCE TO RELATED APPLICATIONS.**
- (c) **STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.**
- (d) **INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC** (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) **BACKGROUND OF THE INVENTION.**
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) **BRIEF SUMMARY OF THE INVENTION.**
- (g) **BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).**
- (h) **DETAILED DESCRIPTION OF THE INVENTION.**
- (i) **CLAIM OR CLAIMS** (commencing on a separate sheet).
- (j) **ABSTRACT OF THE DISCLOSURE** (commencing on a separate sheet).

Headings in bold are usually included.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan US 6,064,875 and further in view of Merchant WO9719548.

As per **claim 1**, Morgan teaches a process for the real-time charge-setting of telecommunication connections between a caller staying outside of his home network in the zone of a foreign mobile phone network and a called subscriber (abstract teaches allowing calls both in and out of home area, which reads on calls to/from the home area to a caller at another location who can be either in or out of the home area as well, figures 1-4 and C10, L5 to C12, L42), comprising:

and the real-time charge-setting take place through the home network (abstract teaches using the HLR to permit calls outside home area by checking if call has been paid, which reads on the claim language

But is silent on the building-up of the telecommunication connection between the calling subscriber and the called subscriber in home network.

Merchant teaches setting up a call connection between a home and non-home locations whereby the a message is sent (Internet, SMS, etc) to a service provider who makes the connection between caller and called party (respectively in home and foreign areas/zones).

It would have been obvious to one skilled in the art at the time of the invention to modify Morgan, such that building of the connections between callers is done in the home network, to provide means for fraud monitoring/reduction.

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As per **claim 2**, Morgan in view of Merchant teaches claim 1 wherein the outgoing connections are locked with the subscriber staying outside of his home network (abstract teaches prohibiting the user from making a call when outside their home network which reads on “outgoing connections are locked”).

As per **claim 3**, Morgan in view of Merchant claim 1 **but is silent on** further comprising that upon the arising of a desire on the part of the calling subscriber for a connection, an information telegram that contains at least the desired target number of the called subscriber and the identity of the calling subscriber is first sent by the calling subscriber to a special network element located at the home network and the special network element, after a check of the data contained in said receive telegram, establishes the connections to the called and calling subscribers.

Merchant teaches sending a data message that includes calling and called parties to the service provider (eg. switch) that makes the connection (page 5, L16-24).

It would have been obvious to one skilled in the art at the time of the invention to modify Morgan, such that the telegram contains target number of called party and identity of caller, to provide means for the connection to be setup by a network element.

As per **claims 4, 9, 10**, Morgan in view of Merchant claim 1/2/3 **but is silent on** whereby the telegram message is drafted and sent as an SMS message.

Merchant discloses multiple known ways in which a message can be sent, including a “data message” via a computer network, a packet-switched network such as SS7 and via a non-signaling network which reads on an SMS message (as is known in the art of cellular communications) [abstract and page 1, L4-8].

It would have been obvious to one skilled in the art at the time of the invention to modify Morgan, such that the telegram message is an SMS message, to provide means for sending the data via cellular messaging service.

As per **claims 5, 11, 12 and 13**, Morgan in view of Merchant claim 1/2/3/4 further comprising the special network element, after checking the current charge credit allocated to the data, builds up the connection between called and calling subscribers (abstract teaches if the call is paid in advance).

As per **claims 6, 14, 15, 16 and 17**, Morgan in view of Merchant claim 1/2/3/4 **but is silent on** further comprising the special network element is implemented in the form of a call back server with connection to intelligent network functions.

Merchant teaches service provider "hardware" that receives the message and dials the destination number of the called party and then bridges the call to the calling party (which reads on the claim).

It would have been obvious to one skilled in the art at the time of the invention to modify Morgan, such that a call-back service and intelligent network functions are used, to provide means for the connection to be established by first checking to see if it has been paid for (eg. intelligence) and then for an intermediate device to provide the connection after authorization.

As per **claims 7, 18, 19 and 20**, Morgan in view of Merchant claim 1/2/3/4 further comprising that the charge coverage of the connections takes place through an IN on-line charge-setting (C5, L50-60 teaches an account memory means that reads on the claim).

As per **claim 8**, Morgan in view of Merchant claim 2 **but is silent on** further comprising that upon the arising of a desire on the part of the calling subscriber for a connection, an information telegram that contains at least the desired target number of the called subscriber and the identity of the calling subscriber is first sent by the calling subscriber to a special network element located at the home network and the special network element, after a check of the data contained in said received telegram, establishes the connections to the called and calling subscribers.

Merchant teaches sending a data message that includes calling and called parties to the service provider (eg. switch) that makes the connection (page 5, L16-24).

It would have been obvious to one skilled in the art at the time of the invention to modify Morgan, such that the telegram contains target number of called party and identity of caller, to provide means for the connection to be setup by a network element.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Gallant et al. US 5,590,175 teaches enhanced call completion.
2. Moll US 5,027,387 teaches reverse directions calling system
3. Fodale US 4,756,020 teaches disallowing extension of a call.
4. Gallant et al. US 5,815,810 teaches improved call connectivity.
5. Hanson US 6,029,062 teaches prepay system with roaming.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 703-306-5426. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

Stephen D'Agosta

